



Attorney's Docket No.: 12938-002001

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Hsuan-Yin Lan-Hargest et al.

Art Unit : 1617

Serial No. : 09/812,945

Examiner : M. Bahar

Filed : March 27, 2001

Title : HISTONE DEACETYLASE INHIBITORS

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Commissioner for Patents
Washington, D.C. 20231

RESPONSE

In response to the action mailed April 23, 2002 ("Office Action"), please amend the application as follows:

In the claims:

Please cancel claims 54-66 without prejudice.

REMARKS

Claims 54-66 have been cancelled without prejudice. Claims 1-53 are pending. Claims 1 and 47 are independent.

Applicants thank the Examiner for withdrawing the rejection under 35 U.S.C. §§ 101/112, first paragraph. See page 2 of the Office Action.

The Examiner indicated that Applicants' request to rejoin Group I and Group II has been denied because "the invention [sic] in Groups I and II are distinct since they have different functions, i.e., inhibition of histone deacetylase vs. treatment of cancer." See page 2 of the Office Action. Applicants continue to disagree. While the Examiner asserts that these are "distinct", Applicants reiterate that both Group I and Group II are drawn to methods of inhibiting histone deacetylase in cells. Both groups are classified in class 514, subclass 575+. Applicants believe the scope of the search required to examine Group I and Group II covers the same material. Applicants respectfully request reconsideration of this aspect of the restriction.

Applicants also respectfully request that claims 21 and 22 be grouped with the claims 1, 2, 4-7, 10, 12, 17-18 and 40-46.

Rejection under 35 U.S.C. § 112, first paragraph

Claims 1, 2, 4-7, 10, 12, 17-18 and 40-46 have been rejected under 35 U.S.C. § 112, first paragraph,

OK to make
MP
08/10/02